**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| Appellant: | Jin-Kwan Kim, *et al.* | Examiner: Wassum, Luke S. |
| Serial No.: | 09/912,522 | Art Unit: 2161 |
| Filed: | July 26, 2001 | Docket No.: 8071-174T (OPP000421US) |
| Title: | **SYSTEM AND METHOD FOR ANALYZING AND UTILIZING INTELLECTUAL PROPERTY INFORMATION** | |

Commissioner of Patents
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## APPEAL BRIEF

In response to the Final Office Action dated July 3, 2008, rejecting claims 4-18 under 35 U.S.C. §101, and rejecting claims 1 and 3-18 under 35 U.S.C. §103(a), Applicant submits this Appeal Brief pursuant to the Notice of Appeal dated October 2, 2008.

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## 1. REAL PARTY IN INTEREST

The real party in interest is Samsung Electronics Co., Ltd., the assignee of Jin-Kwan Kim, Jong-Soo Yoon, and Yea-Sun Yoon, the inventors of the application.

## 2. RELATED APPEALS AND INTERFERENCES

None.

## 3. STATUS OF CLAIMS

Claims 1, 3-7, 9-14, and 16-18 are pending and stand rejected. Claims 1, 3-7, 9-14, and 16-18 are under appeal. A copy of the claims as pending is presented in the Appendix.

## 4. STATUS OF AMENDMENTS

A second Request for Continuing Examination (RCE) was filed for the present application on October 30, 2007. At that time, claims 1, 3-17 had been amended, claim 2 had been canceled, and new claim 18 had been added. In the October 30, 2007 RCE, claims 1, 3, 4, 6, 11, and 13 were amended. Claim 3 was further amended in the response to the January 14, 2008 Official Action, filed on April 3, 2008. In the amendment filed on October 27, 2008, claims 1, 4, and 11 were amended to incorporate subject matter from claims 8, and 15, and claims 8 and 15 were canceled. In the amendment filed on December 1, 2008, claims 4-7, 9-14, and 16-17 were amended to recite "computer units". The claims as presented in the Appendix reflect these amendments to claims 1, 3-7, 9-14, and 16-18.

## 5. SUMMARY OF CLAIMED SUBJECT MATTER

The embodiments of the present invention provide a system and method for analyzing and utilizing intellectual property information, in which an on-line information DB is accessed at predetermined periods using keywords such that intellectual property information is provided to a research center or interested persons, and intellectual property analysis data are accumulated. This enables easy management and analysis of intellectual property information, and makes it easy to utilize the analyzed intellectual property information.

An exemplary system for analyzing and utilizing intellectual property information according to an embodiment of the invention is shown in FIG. 1. As shown in FIG. 1, the system includes on-line information databases (DBs) 100, an IP information extraction unit 200, an IP information analyzing unit 300, an E-mail receiving/transmitting unit 400, a research center analyzing unit 500, and a patent team analyzing unit 600. The on-line information DBs 100 include various IP information disseminated on the Internet and in networks, and are pre-stored material when a client accesses a DB via the Internet and requests particular information. Embodiments of the invention can be implemented in various forms of hardware, software, firmware, special purpose processes, or a combination thereof. For example, the research center analyzing unit 500 includes a plurality of project duty PCs and a plurality of research center PCs, and other units shown in FIG. 1 are similarly implemented.

Independent claims 1, 4, and 11 are representative of the claimed subject matter that embodies features of the invention. For illustrative purposes, the claimed subject matter will be described with reference to exemplary embodiments described in Applicant's specification, and accompanying figures, although nothing herein should be construed as unduly limiting the scope of the claimed subject matter. For each claim listed below, the claim elements are presented in italized text, and are followied by a citation to exemplary figures and/or supporting text paragraph number in Applicant's published specification, U.S. Application Publication No. 2002/0143760.

*1. A method for analyzing and utilizing intellectual property (IP) information, comprising steps of:*

*(a) registering search strategy formulas for extracting IP information into a IP information extraction unit;*

(FIGS. 1 and 2, paragraph [0051], "the IP information analyzing unit 300 first registers a plurality of desired themes at predetermined periods in the IP information extraction unit 200, then generates and registers a plurality of search strategy formulas for extracting IP information with respect to the registered themes.")

*(b) accessing and searching Internet websites that provide IP information based on the registered search strategy formulas, and extracting first IP information according to the search;*

(Paragraph [0052], "IP information extraction unit 200 accesses Internet sites that provide various IP information, and based on the registered search strategy formulas, extracts front pages, converts the front pages into a standard form, and provides this information to the IP information analyzing unit 300.")

*(c) converting the first IP information to a standard form and storing the first IP information, and transmitting the first IP information converted in the standard form to a research center analyzing unit;*

(Paragraph [0053], "IP information analyzing unit 300 receives and stores the data placed in a standard form from the IP information extraction unit 200, and performs automatic mailing to the research center analyzing unit 500".)

*(d) discarding the first IP information upon a determination by the research center analyzing unit that the first IP information is not related to at least one project accessible by the research center analyzing unit;*

(Paragraph [0054], "The research center analyzing unit 500 analyzes technology of IP information provided from the IP information analyzing unit 300, and . . . [i]f it is then determined, based on the registered rank, that the information is not related to the project, the corresponding IP information is discarded.")

*(e) if the first IP information is determined to include IP information that is related to the least one project, accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; and*

( Paragraphs [0054]-[0055], "However, if it is determined that the information is related to the project, detailed information with respect to the corresponding IP information is requested from the IP information analyzing unit 300. . . . the IP information analyzing unit 300 makes a request to the IP information extraction unit 200 for detailed information containing images and text, . . . The IP information extraction unit 200, . . . accesses DBs of suitable sites, downloads and provides the information to the IP information analyzing unit 300.")

*(f) converting the second IP information to the standard form and storing and transmitting the second IP information converted in the standard form to the research center analyzing unit,*

(Paragraph [0056], "The IP information analyzing unit 300 stores the specialized data of the corresponding IP information, and automatically mails them in a standardized format to the research center analyzing unit 500.")

*wherein the step (c) includes steps of:*

*determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents; and*

*storing the third IP information upon receiving the third IP information, and*

(Paragraph [0056], "The research center analyzing unit 500 analyzes the specialized data and prepares opinion. If it is determined after registering the rank . . . that the IP information is related to the project, the prepared opinion is sent back to the IP information analyzing unit 300. At this time, the IP information analyzing unit 300 registers opinion contents based on the research center opinion supplied from the research center analyzing unit 500 or on IP information that is not related to the research center opinion contents.")

*wherein the IP information extraction unit stores a plurality of predetermined keywords.*

(Paragraph [0042], "the management module 360 includes a register unit . . . that stores keywords input by the user. ")

*4. A computer-based system for analyzing and utilizing intellectual property (IP) information, comprising:*

*an IP information extraction computer unit, which is coupled to an IP information analyzing computer unit, for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network and providing the extracted IP information to the IP information analyzing computer unit,*

(Paragraph [0035], "On-line IP information DBs disseminated on the Internet or in networks are accessed in real-time or during predetermined periods, and IP information is extracted according to the operation of software that is programmed to perform specific

functions. The extracted IP information is then provided to the IP information analyzing unit 300.")

*wherein the IP information analyzing computer unit controls the operation of the software, receives the extracted IP information and stores the same together with data containing opinion contents of the extracted IP information from a research center analyzing computer unit, and outputs the extracted IP information;*

(Paragraph [0039], "The IP information analyzing unit 300 controls the operation of software for extracting IP information disseminated on the Internet, receives extracted IP information and stores data containing predetermined opinion contents together with the IP information, and outputs the IP information." )

*an E-mail receiving/transmitting computer unit for transmitting the extracted IP information outputted from the IP information analyzing computer unit to the research center analyzing computer unit, and receiving feedback of the data containing the opinion contents from the research center analyzing computer unit,*

(Paragraph [0045], "The E-mail receiving/transmitting unit 400 transmits IP information from the IP information analyzing unit 300 to PCs included in the research center analyzing unit 500, which is linked to IP information. The E-mail receiving/transmitting unit 400 then receives data containing opinion contents from the PCs and supplies the same to the IP information analyzing unit 300.")

*wherein the research center analyzing computer unit is coupled to the IP information extraction computer unit*

(FIG. 1, paragraph [0033], "the system for analyzing and utilizing intellectual property (IP) information . . . includes on-line information databases (DBs) 100, an IP information extraction unit 200, an IP information analyzing unit 300, an E-mail receiving/transmitting unit 400, a research center analyzing unit 500, and a patent team analyzing unit 600.")

*and wherein the research center analyzing computer unit determines whether the extracted IP information includes IP information that is related to at least one project accessible by the research center analyzing computer unit, and discarding the IP information upon a determination that the IP information is not related to the at least one project accessible by the*

*research center analyzing computer unit, and if the extracted IP information is determined to include IP information that is related to the at least one project, requesting detailed information corresponding to the IP information that is related to the at least one project from the IP information extraction computer unit,*

(Paragraph [0046], "If the research center analyzing unit 500 analyzes and classifies IP information supplied from the IP information analyzing unit 300 via the E-mail receiving/transmitting unit 400 and determines that the IP information is not related to the project, the information is deleted. However, if it is determined that the information is related to the project, the research center analyzing unit 500 makes detailed information requests with respect to the corresponding information to the E-mail receiving/transmitting unit 400.")

*wherein the IP information extraction computer unit comprises:*

*a front page extraction computer unit for requesting front pages of IP information according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages, and*

(Paragraph [0036], "the front page extraction unit 210--based on registered themes (or technical classification), search strategy formulas and E-mail addresses, etc., provided from the IP information analyzing unit 300--accesses the on-line IP information DBs 100 and extracts front pages. The front page extraction unit 210 then supplies the extracted front pages to the data converter 220. The data converter 220 converts data of the front pages supplied from the front page extraction unit 210, then provides the converted data to the IP information analyzing unit 300.")

*wherein the IP information extraction computer unit stores a plurality of predetermined keywords.*

(Paragraph [0042], "the management module 360 includes a register unit . . . that stores keywords input by the user. ")

*11. A computer-based system for analyzing and utilizing intellectual property (IP) information, comprising:*

*an IP information extraction computer unit, which is coupled to an IP information analyzing computer unit, for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network and providing the extracted IP information to the IP information analyzing computer unit,*

(Paragraph [0035], "On-line IP information DBs disseminated on the Internet or in networks are accessed in real-time or during predetermined periods, and IP information is extracted according to the operation of software that is programmed to perform specific functions. The extracted IP information is then provided to the IP information analyzing unit 300.")

*wherein the IP information analyzing computer unit controls the operation of the software, provides technical classifications and search strategy formulas to the IP information extraction computer unit, receives the extracted IP information and stores the same together with data containing opinion contents of the extracted IP information from a research center analyzing computer unit, and outputs the extracted IP information;*

(Paragraph [0039], "The IP information analyzing unit 300 controls the operation of software for extracting IP information disseminated on the Internet, receives extracted IP information and stores data containing predetermined opinion contents together with the IP information, and outputs the IP information." )

*an E-mail receiving/transmitting computer unit for transmitting the extracted IP information outputted from the IP information analyzing computer unit to the research center analyzing computer unit, and receiving feedback of the data containing the opinion contents from the research center analyzing computer unit,*

(Paragraph [0045], "The E-mail receiving/transmitting unit 400 transmits IP information from the IP information analyzing unit 300 to PCs included in the research center analyzing unit 500, which is linked to IP information. The E-mail receiving/transmitting unit 400 then receives data containing opinion contents from the PCs and supplies the same to the IP information analyzing unit 300.")

*wherein the research center analyzing computer unit is coupled to the IP information extraction computer unit*

(FIG. 1, paragraph [0033], "the system for analyzing and utilizing intellectual property (IP) information . . . includes on-line information databases (DBs) 100, an IP information extraction unit 200, an IP information analyzing unit 300, an E-mail receiving/transmitting unit 400, a research center analyzing unit 500, and a patent team analyzing unit 600.")

*and wherein the research center analyzing computer unit determines whether the extracted IP information includes IP information that is related to at least one project accessible by the research center analyzing computer unit, and if the extracted IP information is determined to include IP information that is related to the at least one project, requesting detailed information corresponding to the IP information that is related to the at least one project from the IP information extraction computer unit, and discarding the IP information upon a determination that the IP information is not related to the at least one project accessible by the research center analyzing computer unit,*

(Paragraph [0046], "If the research center analyzing unit 500 analyzes and classifies IP information supplied from the IP information analyzing unit 300 via the E-mail receiving/transmitting unit 400 and determines that the IP information is not related to the project, the information is deleted. However, if it is determined that the information is related to the project, the research center analyzing unit 500 makes detailed information requests with respect to the corresponding information to the E-mail receiving/transmitting unit 400.")

*and*

*wherein the IP information extraction computer unit stores a plurality of predetermined keywords.*

(Paragraph [0042], "the management module 360 includes a register unit . . . that stores keywords input by the user. ")

## 6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

**A.** Whether the subject matter claimed in each of Claims 4-7, 9-14, and 16-18, taken as a whole, constitutes patentable subject matter under 35 U.S.C. §101.

**B.** Whether the subject matter claimed in each of Claims 1 and 3, taken as a whole, is obvious to a person having ordinary skill in the art, over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*).

**C.** Whether the subject matter claimed in each of Claims 4-7, 9-14, and 16-17, taken as a whole, is obvious to a person having ordinary skill in the art, over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*), and further in view of U.S. Patent No. 5,862,223 (Walker, *et al.,*).

**D.** Whether the subject matter claimed in Claim 18, taken as a whole, is obvious to a person having ordinary skill in the art, over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*) and U.S. Patent No. 5,862,223 (Walker, *et al.,*), and further in view of U.S. Patent No. 6,088,765 (Ohtsuka).

## 7. ARGUMENT

### A. The subject matter claimed in each of Claims 4-7, 9-14, and 16-18, taken as a whole, constitutes patentable subject matter under 35 U.S.C. §101.

Applicant has amended claims 4-7, 9-14, and 16-17 to recite an IP information extraction computer unit, an IP information analyzing computer unit, a research center analyzing computer unit, an E-mail receiving/transmitting computer unit, a front page extraction computer unit, a specialized information extraction computer unit, a quantitative analysis computer unit, and a DB management computer unit. These claim elements have been claimed in combination with appropriate hardware to enable the functionality of the various units and to establish a statutory category for the claimed invention, consitent with the recent *en banc* Federal Circuit Court of Appeals decision in *In re Bilski*. Accordingly, these claims are not software *per se*, and the rejection of these claims under section 101 should be reversed.

### B. The subject matter claimed in each of Claims 1 and 3, taken as a whole, was not obvious to a person having ordinary skill in the art, over U.S. Patent No. 5,721,910

**(Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*), at the time the invention of the present application was made.**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teaching. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference must teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. If an independent claim is non-obvious under section 103, then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Unger is directed to a database and a method of producing that database which can be used to determine the meaning of scientific or technical documents, and to assign the technical documents to one or more scientific or technical categories within a multidimensional hierarchical model which reflects the business, scientific or technical interests of a business, scientific or technical entity or specialty. This database disaggregates a set of patents and/or technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model. The pre-defined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of a scientific or business discipline. The categorization may then be used by the relational database to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents. The categorization may also be used to allow the technical experts to examine the underlying documents and/or abstracts and/or claims which contribute to these trends and discontinuities. In order to create this database, the computer system has a pre-defined model of the overall scientific or business discipline and has analyzed the technical content of each patent or technical document with respect to that model. This Technical Subject Hierarchy is used to create a set of

sophisticated expert technical searches, using technical indexing along with the text of the patent abstracts and/or the patent claims and/or the technical document. An expert search is created to identify patents or technical documents that are pertinent to each individual category within the Customized Technical Subject Hierarchy and the results of these searches are electronically stored in tables. The set of expert searches represented by Stage IV can be automatically executed against a new set of patents and/or technical documents.

Regarding claim 1, the Examiner cited Unger, col. 3, lines 46-51 as disclosing transmitting the first IP information converted in the standard form to a research center analyzing unit and transmitting the second IP information converted in the standard form to the research center analyzing unit, as recited in claim 1. This section of Unger states:

> The documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model. The documents and/or abstracts and/or claims and/or technical indexing may be displayed on a computerized graphical interface.

This passage is concerned with how data is stored in a database, and linked to a hierarchical model. The Examiner has further contended that a computerized graphical interface can be interpreted as a research center analyzing unit to allege that Unger teaches transmitting first and second IP information converted into a standard format to the research center analyzing unit. However, a research center analyzing unit is clearly not a graphical interface, as a graphical interface serves only to display information, not to analyze it, and the format into which data is converted for display purposes is specific to the graphical interface, and does not teach or suggest a standard format. Thus, contrary to the Examiner's allegation, there is nothing in this passage about *transmitting the first IP information converted in the standard form to a research center analyzing unit*, or *transmitting the second IP information converted in the standard form to the research center analyzing unit.*

The Examiner also cited Unger, col. 2, lines 40-46 as disclosing *accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information.* This section of Unger states:

> Specific detail on individual documents and/or abstracts and/or claims may also be captured in discrete fields and linked to the categories within the hierarchical model and the technical documents and/or abstracts and/or claims. All of the above data may also be linked to full-text sources of the documents.

Again this passage is concerned with how data is linked to the categories of a hierarchical model. The Examiner interprets Unger's full text document sources as equivalent to Applicant's second IP information corresponding to the first IP information. However, this passage simply describes a single set of information, and does not disclose or suggest a sequence of steps of extracting and analyzing first IP information, and if relevant to at least one project, extracting second IP information corresponding to the first IP information. Thus, contrary to the Examiner's allegation, there is nothing in this passage about *extracting second IP information corresponding to the first IP information upon a request for detailed information.*

The Examiner cited Unger, col. 10, lines 40-48 and col. 11, lines 34-45 as disclosing *determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents.* The relevant paragraph in col. 10 of Unger is directed to applying mathematical methods to derive more abstract concepts from the set of stored category assignments. Col. 10, lines 40-48 states:

> These more abstract concepts can be identified by the use of both the matrix of technical and/or scientific concepts, identified by the application of expert technical searches, and a matrix of stored expert opinion. The matrix of stored expert opinion represents the cumulative opinion of a group of expert technical staff and/or scientists, on the fractional contribution of each technical and/or scientific concept to each of the higher-level, more abstract concepts.

This passage is thus concerned with mathematical techniques to identifying abstract concepts in the stored categories. Col. 11, lines 34-38 states:

> Table 5 represents the cumulative knowledge of a group of technical experts in a given business or technical entity. For example, Table 5 may represent the collective opinion of a group of technical experts on the contribution of a patent in Drill Bit Topology to a series of higher level concepts.

The remainder of the paragraph describes examples of cumulative knowledge. The Examiner's comment that making a determination of whether expert information has been received wouild

be a prerequisite to the storage of such information, is irrelevant to Applicant's claim recitation of *determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents*. These passages do not disclose *determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents*, contrary to the Examiner's allegation.

The Examiner cited Unger, col. 5, lines 64-66 as teaching that *the IP information extraction unit stores a plurality of predetermined keywords*. The paragraph of Col. 5, lines 64-66 states:

> The set of expert searches represented by Stage IV can be automatically executed against a new set of patents and/or technical documents. This new set of patents and/or technical documents may represent either recently published patents or technical documents and/or recently identified patents or technical documents and/or older collections of patents or technical documents which are now being captured with the methods of this invention.

The Stage IV refers to a hierarchical model of the specific interests of a business entity or technical or scientific specialty that consists of two or more levels, each level consisting of sets of categories which define the concepts being modeled. The higher level terms correspond to a broader, more abstract genus and the lower level categories correspond to a more specific set of sub-categories corresponding to the species. This hierarchy is used to create a set of sophisticated expert technical searches (ETS), using the best chemical and technical indexing available along with the text of the patent abstracts and/or the patent claims and/or the technical document. An expert search is created to identify patents or technical documents that are pertinent to each individual category within the hierarchy, and the results of these searches are electronically stored in tables. These expert searches use categories and actual document text to find other documents relevant to the categories, which are then stored. Thus, Unger does not teach or suggest *storing a plurality of predetermined keywords*.

Thus, Unger fails to disclose or suggest *extracting first IP information according to a search strategy; transmitting the first IP information . . . to a research center analyzing unit; . . . determining if third IP information has been received from the research center analyzing unit,*

*the third IP information including technical analyses and opinion contents . . . accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; and . . . transmitting the second IP information . . . to the research center analyzing unit, . . . wherein the IP information extraction unit stores a plurality of predetermined keywords,* as recited in claim 1. Unger only discloses a database and methods for producing and maintaining that database.

The Examiner cited Adler as disclosing a relevancy filter, and alleged that this filter teaches Applicant's claim step of *discarding the first IP information upon a determination by the research center analyzing unit that the first IP information is not related to at least one project accessible by the research center analyzing unit.* Adler is directed to a computer implemented electronic records system and a data processing system for automatically maintaining an electronic laboratory records system. However, Adler fails to disclose or suggest a *an IP information extraction unit, an IP information analyzing unit,* or *a research center analyzing unit,* or Applicant's sequence of steps, and thus fails to rectify the deficiencies of Unger.

Thus, since the combination of Unger and Adler fails to disclose or suggest all limitations of claim 1, this claim is not obvious over Unger and Adler, and this rejection should be reversed.

Claim 3 depends from claim 1, and is patentable for at least the same reasons as claim 1. Accordingly, the rejection of claim 3 should also be reversed.

**C. The subject matter claimed in each of Claims 4-7, 9-14, and 16-17, taken as a whole, was not obvious to a person having ordinary skill in the art, over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*), and further in view of U.S. Patent No. 5,862,223 (Walker, *et al.,*), at the time the invention of the present application was made.**

The arguments concerning Unger presented above in connection with the section 103 rejection of claims 1 and 3 are equally applicable to the rejections of claims 4-7, 9-14, and 16-17. The Examiner cited Walker as disclosing a system with an email receiving/transmitting unit. However, Walker is directed to managing communications between an expert having particular

qualifications and an end user seeking a solution to an expert request. Walker does not teach or suggest accessing on-line information DB at predetermined periods using keywords to provide intellectual property information to a research center that accumulates intellectual property analysis data, and thus Walker fails to rectify the deficiencies of Unger and Adler discussed above.

Thus, since the combination of Unger, Adler and Walker fails to disclose or suggest all limitations of claims 4 and 11, these claims are not obvious over Unger, Adler and Walker. Accordingly, these rejections should be reversed.

Claims 5-7, 9-10, 12-14, and 16-17 depend from claims 4 and 11, respectively, and are thus patentable for at least the same reasons as claims 4 and 11. Accordingly, these rejections should be reversed.

**D. The subject matter claimed in Claim 18, taken as a whole, was not obvious to a person having ordinary skill in the art, over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*) and U.S. Patent No. 5,862,223 (Walker, *et al.*,), and further in view of U.S. Patent No. 6,088,765 (Ohtsuka), at the time the invention of the present application was made.**

Claim 18 depends from claim 11 through claim 14, and thus the arguments presented above regarding Unger, Adler, and Walker in connection to claims 1, 4, and 11 are applicable to claim 18. The Examiner cited Ohtsuka as disclosing a system in which predetermined intervals are determined based on the number of times a user connects to the computer-based system for analyzing and utilizing IP information. Ohtsuka is directed to a removable medium data storage apparatus that can read and store data. However, Ohtsuka does not teach or suggest accessing on-line information DB at predetermined periods using keywords to provide intellectual property information to a research center that accumulates intellectual property analysis data, and thus Ohtsuka fails to rectify the deficiencies of Unger, Adler, and Walker as discussed above. Since the combination of Unger, Adler, Walker and Ohtsuka fails to disclose or suggest all claimed

limitations of claim 18, a *prima facie* case of obviousness of claim 18 over Unger, Adler, Walker and Ohtsuka cannot be maintained. Accordingly, this rejection should be reversed.

## 8. CONCLUSION

Applicant has amended claims 4-7, 9-14, and 16-17 to recite hardware consistent with the requirements of *In re Bilski*, and therefore these claims are directed to statutory subject matter under section 101. Furthermore, the Examiner has failed to show that the combination of Unger and Adler teach or suggest all limitations of claims 1 and 3, that the combination of Unger, Adler, and Walker teach or suggest all limitations of claims 4-7, 9-14, and 16-17, and that the combination of Unger, Adler, Walker and Ohtsuka teach or suggest all limitations of claim 18, and thus the Examiner has failed to establish a *prima facie* case of obviousness of claims 1, 3-7, 9-14, and 16-18 of the application. Reversal of the rejections and allowance of the rejected claims is urged.

Respectfully submitted,

Dated: 12/2/08

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## CLAIMS APPENDIX

1. (Rejected) A method for analyzing and utilizing intellectual property (IP) information, comprising steps of:

(a) registering search strategy formulas for extracting IP information into a IP information extraction unit;

(b) accessing and searching Internet websites that provide IP information based on the registered search strategy formulas, and extracting first IP information according to the search;

(c) converting the first IP information to a standard form and storing the first IP information, and transmitting the first IP information converted in the standard form to a research center analyzing unit;

(d) discarding the first IP information upon a determination by the research center analyzing unit that the first IP information is not related to at least one project accessible by the research center analyzing unit;

(e) if the first IP information is determined to include IP information that is related to the least one project, accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; and

(f) converting the second IP information to the standard form and storing and transmitting the second IP information converted in the standard form to the research center analyzing unit,

wherein the step (c) includes steps of:

determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents; and

storing the third IP information upon receiving the third IP information, and

wherein the IP information extraction unit stores a plurality of predetermined keywords.

2. (Canceled)

3. (Rejected) The method of claim 1, wherein step (e) includes steps of:

determining if fourth IP information has been received from the research center analyzing unit, the fourth IP information including technical analyses and opinion contents; and

storing the fourth IP information upon receiving the fourth IP information.

4. (Rejected) A computer-based system for analyzing and utilizing intellectual property (IP) information, comprising:

an IP information extraction computer unit, which is coupled to an IP information analyzing computer unit, for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network and providing the extracted IP information to the IP information analyzing computer unit,

wherein the IP information analyzing computer unit controls the operation of the software, receives the extracted IP information and stores the same together with data containing opinion contents of the extracted IP information from a research center analyzing computer unit, and outputs the extracted IP information; and

an E-mail receiving/transmitting computer unit for transmitting the extracted IP information outputted from the IP information analyzing computer unit to the research center analyzing computer unit, and receiving feedback of the data containing the opinion contents from the research center analyzing computer unit,

wherein the research center analyzing computer unit is coupled to the IP information extraction computer unit and wherein the research center analyzing computer unit determines whether the extracted IP information includes IP information that is related to at least one project accessible by the research center analyzing computer unit, and discarding the IP information upon a determination that the IP information is not related to the at least one project accessible by the research center analyzing computer unit, and if the extracted IP information is determined to include IP information that is related to the at least one project, requesting detailed information corresponding to the IP information that is related to the at least one project from the IP information extraction computer unit,

wherein the IP information extraction computer unit comprises:

a front page extraction computer unit for requesting front pages of IP information according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages, and

wherein the IP information extraction computer unit stores a plurality of predetermined keywords.

5. (Rejected) The computer-based system of claim 4, wherein the IP information extraction computer unit further comprises:

a data converter for converting front page data and outputting the same to the IP information analyzing computer unit; and

a specialized information extraction computer unit for requesting specialized IP information according to a URL for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the specialized IP information.

6. (Rejected) The computer-based system of claim 4, wherein the IP information analyzing computer unit comprises:

a first DB for storing patent team opinion contents of at least one of front pages or specialized pages;

a second DB for storing research center opinion contents of at least one of front pages or specialized pages;

a quantitative analysis computer unit for outputting predetermined quantitative analysis graphs;

a management module for generating technical classifications and search strategy formulas for extracting IP information; and

a DB management computer unit for receiving the front pages or specialized pages from the IP information extraction computer unit and storing this information in the first DB, storing the research center opinion contents received from the research center analyzing computer unit in the second DB, and outputting signals for generating analysis graphs to the quantitative analysis computer unit.

7. (Rejected) The computer-based system of claim 4, wherein extraction periods of the IP information extraction computer unit are in real-time or programmed at predetermined intervals.

8. (Canceled)

9. (Rejected) The computer-based system of claim 4, wherein the IP information analyzing computer unit separates and displays analyzed data and data that have not been analyzed.

10. (Rejected) The computer-based system of claim 4, wherein the E-mail receiving/transmitting computer unit registers a plurality of predetermined E-mail addresses according to subject or field.

11. (Rejected) A computer-based system for analyzing and utilizing intellectual property (IP) information, comprising:

an IP information extraction computer unit, which is coupled to an IP information analyzing computer unit, for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network and providing the extracted IP information to the IP information analyzing computer unit,

wherein the IP information analyzing computer unit controls the operation of the software, provides technical classifications and search strategy formulas to the IP information extraction computer unit, receives the extracted IP information and stores the same together with data containing opinion contents of the extracted IP information from a research center analyzing computer unit, and outputs the extracted IP information; and

an E-mail receiving/transmitting computer unit for transmitting the extracted IP information outputted from the IP information analyzing computer unit to the research center analyzing computer unit, and receiving feedback of the data containing the opinion contents from the research center analyzing computer unit,

wherein the research center analyzing computer unit is coupled to the IP information extraction computer unit and wherein the research center analyzing computer unit determines whether the extracted IP information includes IP information that is related to at least one project accessible by the research center analyzing computer unit, and if the extracted IP information is determined to include IP information that is related to the at least one project, requesting detailed

information corresponding to the IP information that is related to the at least one project from the IP information extraction computer unit, and discarding the IP information upon a determination that the IP information is not related to the at least one project accessible by the research center analyzing computer unit, and

wherein the IP information extraction computer unit stores a plurality of predetermined keywords.

12. (Rejected) The computer-based system of claim 11, wherein the IP information extraction computer unit comprises:

a front page extraction computer unit for requesting front pages of IP information according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages;

a data converter for converting front page data and outputting the same to the IP information analyzing computer unit; and

a specialized information extraction computer unit for requesting specialized IP information according to a URL for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the specialized IP information.

13. (Rejected) The computer-based system of claim 11, wherein the IP information analyzing computer unit further comprises:

a first DB for storing patent team opinion contents of at least one of front pages or specialized pages;

a second DB for storing research center opinion contents of at least one of front pages or specialized pages;

a quantitative analysis computer unit for outputting predetermined quantitative analysis graphs; and

a DB management computer unit for receiving the front pages or specialized pages from the IP information extraction computer unit and storing this information in the first DB, storing the research center opinion contents received from the research center analyzing computer unit in

the second DB, and outputting signals for generating analysis graphs to the quantitative analysis computer unit.

14. (Rejected) The computer-based system of claim 11, wherein extraction periods of the IP information extraction computer unit are in real-time or programmed at predetermined intervals.

15. (Canceled)

16. (Rejected) The computer-based system of claim 11, wherein the IP information analyzing computer unit separates and displays analyzed data and data that have not been analyzed.

17. (Rejected) The computer-based system of claim 11, wherein the E-mail receiving/transmitting computer unit registers a plurality of predetermined E-mail addresses according to subject or field.

18. (Rejected) The computer-based system of claim 14, wherein the predetermined intervals are determined based on the number of times a user connects to the computer-based system for analyzing and utilizing IP information.

## EVIDENCE APPENDIX

None.

## RELATED PROCEEDINGS APPENDIX

None.